PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

To:

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NOTIFICATION OF TRANSMITTAL OF THE INTERNATIONAL PRELIMINARY EXAMINATION REPORT
(PCT Rule 71.1)

Date of mailing *(day/month/year)*	06.12.2004
Applicant's or agent's file reference	IMPORTANT NOTIFICATION
FPAA335PCT	

International application No.	International filing date *(day/month/year)*	Priority date *(day/month/year)*
PCT/IN 03/00289	27.08.2003	28.08.2002

Applicant
LUPIN LTD. et al.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.

2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.

3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed inventions is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the international preliminary examining authority:

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D-80298 Munich
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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference FPAA335PCT	FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. PCT/IN 03/00289	International filing date *(day/month/year)* 27.08.2003	Priority date *(day/month/year)* 28.08.2002
International Patent Classification (IPC) or both national classification and IPC A61K35/78		
Applicant LUPIN LTD. et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

   ☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

   These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

   - I ☒ Basis of the opinion
   - II ☐ Priority
   - III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
   - IV ☐ Lack of unity of invention
   - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
   - VI ☐ Certain documents cited
   - VII ☐ Certain defects in the international application
   - VIII ☐ Certain observations on the international application

Date of submission of the demand	Date of completion of this report
10.03.2004	06.12.2004
Name and mailing address of the international preliminary examining authority: European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Stoltner, A Telephone No. +49 89 2399-8408

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/IN 03/00289

I. Basis of the report

1. With regard to the **elements** of the international application: *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17))*:

Description, Pages

1-29 as originally filed

Claims, Numbers

1-19 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

   These elements were available or furnished to this Authority in the following language: , which is:

   ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).

   ☐ the language of publication of the international application (under Rule 48.3(b)).

   ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

   ☐ contained in the international application in written form.

   ☐ filed together with the international application in computer readable form.

   ☐ furnished subsequently to this Authority in written form.

   ☐ furnished subsequently to this Authority in computer readable form.

   ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

   ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

   ☐ the description, pages:

   ☐ the claims, Nos.:

   ☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

   (Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

   ☐ the entire international application,

   ☒ claims Nos. 19

   because:

   ☐ the said international application, or the said claims Nos. relate to the following subject matter which does not require an international preliminary examination (specify):

   ☐ the description, claims or drawings *(indicate particular elements below)* or said claims Nos. are so unclear that no meaningful opinion could be formed *(specify)*:

   ☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

   ☒ no international search report has been established for the said claims Nos. 19 (relative to a method of treatment practised on the animal/human body)

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

   ☐ the written form has not been furnished or does not comply with the Standard.

   ☐ the computer readable form has not been furnished or does not comply with the Standard.

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	1-19
	No:	Claims	
Inventive step (IS)	Yes:	Claims	
	No:	Claims	1-19
Industrial applicability (IA)	Yes:	Claims	1-19 (except claim 19 for some contracting states within the PCT)
	No:	Claims	

2. Citations and explanations

   see separate sheet

ad section V:

1). The Applicant's submissions presented in his letter Fax dated 19/10/2004 have been considered. Hereto the following has to be noted:

a) According to the applicant, the "present invention relates to the anti-convulsant activity in this saponin mixture extracted from fruit of *S. trifoliatus* which contains hederagenin in a defined amount." The saponins present in the extract have been isolated and identified, resulting in a mixture of 6 hederagenin derivatives (cf. page 16, lines 10ff.). Moreover, the examiner's attention is drawn to page 17, where the hederagenin indicated in the present invention is always in relation to saponins as derived from the pericarp of the fruit of *S. trifoliatus.*
However, on page 17, 2nd para., the contents of the abovementioned saponins (as aglycone or not) present in the extract is calculated as "hederagenin".
Therefore, in the absence of a more precise definition for the term "extract of the pericarp of the fruit of *S. trifoliatus*" , it has to be construed, that an extract comprising from 0.001 to 1.0 (% w/v) of "hederagenin" including hederagenin as aglycone or in a saponified form according to the definition in page 17, 2nd para., is intended.

b) The present application merely concerns a **pharmaceutical composition** according to the technical characteristics **depicted in I) and II)** of the present main claim 1.

c) The active principle of the presently claimed composition is seen in an undefined extract derived from *S. trifoliatus* containing 0.0001 to 1.0 (% w/v) of "hederagenin".

d) No difference can be seen between a "hederagenin" isolated from S. trifoliatus and a hederagenin isolated from another plant source, as far as the chemical structure for triterpenoid saponins or "hederagenin" is assumed to be the same irrespective of the plant from which isolate such compounds are obtained. The same has to be assumed to apply for the physiological effects exhibited by these compounds obtainable from different sources.

2). Although no explicit disclosure is made about "an extract of the pericarp of the fruit

of *S. trifoliatus*, compositions comprising from 0.001 to 1.0(%w/v) of hederagenin and pharmaceutically acceptable additives are known in the prior art (cf. D1/D2). Moreover, a clear pointer is given in D1, where hederagenin (as aglycone or not) is administered in anticonvulsant determination assays, to use the presently claimed compositions in anticonvulsive therapy with a reasonable expectation of success. Therefore, in spite that novelty has to be strictly recognised and in the absence of convincing results proving for unexpected and surprising effects, the presently claimed compositions are not considered inventive over the prior art teaching (D1) thus failing to comply with Art. 33(3) PCT.

3). For the assessment of the present claim 19 on the question whether it is industrially applicable, no unified criteria exist in the PCT Contracting States. The patentability can also be dependent upon the formulation of the claims. The EPO, for example, does not recognize as industrially applicable the subject-matter of claims to the use of a compound in medical treatment, but may allow, however, claims to a known compound for first use in medical treatment and the use of such a compound for the manufacture of a medicament for a new medical treatment.

4). General statements in the description trying to extend the scope of protection in an ambiguous and unclear way (cf. page 27, "..non-limiting") are to be avoided.